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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/810,159
Filing Date: March 19, 2001
Appellant(s): WU ET AL.

America Online, Inc.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/12/07 appealing from the Office action
mailed 4/19/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-25, 37-39, and 41-44.

Claims 27-36 have been withdrawn from consideration as not directed to the elected group.

Claims 26 and 40 have been canceled.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6879665

Cook et al

04-2005

PowWos (2000, March 1). Introduction. Retrieved April 3, 2006 from Web site:

http://web.archive.org/web/20000301125635/ww2.tribal.com/help/online_docs/h205voice.html

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-25, 37-39, and 41-44 are rejected under 35 U.S.C. 103(a) as being anticipated by Cook et al (USPN: 6879665) hereinafter referred to as Cook further in view of PowWow (NPL dated 3/1/2000).

As to claim 1, Cook teaches a communications method comprising: establishing a text messaging communication session between a sender and a recipient through a messaging host; (col 2, lines 31-46; a session is established wherein the user can send and receive messages)

facilitating a text message to be sent from the sender to the recipient during the session, the text message including message text inputted by the sender; (col 2, lines 31-46; the user sends the text message where the text is inputted by the sender)

enabling presentation of a first text messaging graphical user interface to the recipient that includes a display of the message text and an icon, the presentation of the first text messaging graphical user interface being conditioned on communication of the text message between the sender and the recipient; and (Figs 5A-8; col 2, lines 31-46; col 7, lines 5-28; a display is presented in which an icon is available conditioned upon transmission of the text message)

enabling manipulation by the recipient of the icon to invoke voice communication between the sender and the recipient through the instant messaging host. (col 2, lines 31-46; col 6, lines 26-41; col 7, lines 5-28; the icon/button is activated)

However, Cook does not explicitly indicate that the text message is an instant message. PowWow teaches a similar system as Cook that facilitates voice instant messages. Furthermore, a voice chat can be carried out in a plurality of ways. In all such cases, one must have a connection with a person. In one method, if a user is connected via instant messaging, an icon labeled the voice button can be activated and thus initiate a voice chat (see Method 2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of PowWow into those of Cook to make the system versatile. In analogous art such as Cook, one would have a greater advantage

in providing features such as instant voice messaging, integrated voice chat, instant messaging, and point to multi-point communications.

As to claim 2, Cook teaches the method of claim 1 further comprising receiving and authenticating the text instant message from the sender at the instant messaging host (Fig 5; col 6, lines 26-41; the authentication system is inherent within any email/voicemail/text messaging system).

As to claim 3, Cook teaches the method of claim 2 wherein authenticating the text instant message comprises identifying a screen name associated with at least one of the sender and the recipient. (Fig 5; col 6, lines 26-41; the authentication system is inherent within any email/voicemail/text messaging system)

As to claim 4, Cook teaches the method of claim 2 wherein authenticating the text instant message comprises identifying an IP address associated with at least one of the sender and the recipient (Fig 5; col 3, lines 47-60; col 6, lines 26-41; the authentication system is inherent within any email/voicemail/text messaging system. A system that employs the TCP/IP suite, such as the one disclosed by Cook, always check for sender/receiver or sending/destination address.).

As to claim 5, Cook teaches the method of claim 1 further comprising determining voice communication capabilities of the recipient at the instant messaging host.(col 6, lines 42-60)

As to claim 6, Cook teaches the method of claim 5 wherein determining voice communication capabilities comprises identifying hardware associated with the recipient. (col 6, lines 42-60)

As to claim 7, Cook teaches the method of claim 5 wherein determining voice communication capabilities comprises identifying software associated with the recipient. (col 6, lines 42-60)

As to claim 8, Cook teaches the method of claim 5 further comprising reporting the voice communication capabilities of the recipient to the sender. (col 6, lines 42-60)

As to claim 9, Cook teaches the method of claim 8 further comprising presenting a second text instant messaging interface to the sender that varies according to the capabilities of the recipient. (col 6, lines 42-60)

As to claim 10, Cook teaches the method of claim 1 further comprising receiving, at the instant messaging host, a request to establish voice communication (col 2, lines 31-46; col 6, lines 26-41; col 7, lines 5-28)

As to claim 11, Cook teaches the method of claim 10 wherein the request is from the sender (col 2, lines 31-46; col 6, lines 26-41; col 7, lines 5-28).

As to claim 12, Cook teaches the method of claim 10 wherein the request is from the recipient (col 2, lines 31-46; col 6, lines 26-41; col 7, lines 5-28).

As to claim 13, Cook teaches the method of claim 10 further comprising authenticating the request (Fig 5; col 6, lines 26-41; the authentication system is inherent within any email/voicemail/text messaging system)

As to claim 14, Cook teaches the method of claim 11 wherein authenticating the request comprises identifying a screen name associated with at least one of the sender and the recipient. (Fig 5; col 6, lines 26-41; the authentication system is inherent within any email/voicemail/text messaging system)

As to claim 15, Cook teaches the method of claim 11 wherein authenticating the request comprises identifying an IP address associated with at least one of the sender and the recipient. (Fig 5; col 6, lines 26-41; the authentication system is inherent within any email/voicemail/text messaging system)

As to claim 16, Cook teaches the method of claim 1 wherein enabling voice communication comprises establishing a generic signaling interface channel, a control channel, and an audio channel between the sender and the recipient.(col 3, lines 46-60)

As to claim 17, Cook teaches the method of claim 16 further comprising attempting a mode UDP test on the audio channel (col 3, lines 27-36 and lines 46-60).

As to claim 18, Cook teaches the method of claim 16 wherein the control channel comprises a TCP/IP socket. (col 3, lines 46-60)

As to claim 19, Cook teaches the method of claim 16 wherein the audio channel comprises a UDP channel (col 3, lines 27-36 and lines 46-60).

As to claim 20, Cook teaches the method of claim 16 wherein the audio channel comprises a TCP channel. (col 3, lines 46-60)

Claims 21-22 are rejected under the same rationale as the above-mentioned claim 1.

As to claim 23, Cook teaches the computer program of claim 22 wherein the computer readable medium is a disc. (col 5, lines 11-39)

As to claim 24, Cook teaches the computer program of claim 22 wherein the computer readable medium is a client device. (col 5, lines 11-39)

As to claim 25, Cook teaches the computer program of claim 22 wherein the computer readable medium is a host device. (col 5, lines 11-39)

As to claim 37, Cook teaches the method of claim 1, wherein enabling manipulation of icon by the recipient to invoke voice communication comprises enabling manipulation by the recipient to invoke voice communication in response to delivery of the text instant message to the recipient. (col 2, lines 31-46; col 6, lines 26-41; col 7, lines 5-28)

As to claim 38, Cook teaches the apparatus of claim 21, wherein the instant messaging host is configured to enable manipulation of the icon by the recipient to invoke voice communication by enabling manipulation by the recipient to invoke voice communication in response to delivery of the text instant message to the recipient. (col 2, lines 31-46; col 6, lines 26-41; col 7, lines 5-28)

As to claim 39, Cook teaches the computer program of claim 22, wherein the instructions for enabling manipulation of the icon by the recipient to invoke voice communication include instructions for enabling manipulation by the recipient to invoke voice communication in response to delivery of the text instant message to the recipient. (col 2, lines 31-46; col 6, lines 26-41; col 7, lines 5-28)

As to claim 41, Cook teaches the communications method of claim 1, wherein the presentation of the first text instant messaging graphical user interface being conditioned on communication of the text instant message comprises not presenting the first text instant messaging graphical user interface if the text instant message is not received by the recipient. (col 2, lines 31-46; col 6, lines 26-41; col 7, lines 5-28)

Claims 42-43 are rejected under the same rationale as the above-mentioned claims 21-22.

Claim 44 contains similar limitations as above-rejected claim 1. Therefore, it is rejected under similar rationale.

(10) Response to Argument

The examiner summarizes the various points raised by the appellant and addresses them individually.

As per appellant's arguments filed, the appellant argues:

Impermissible hindsight has been used to combine the disclosures of Cook and PowWow leading to an improper combination and failing to teach the appellant's invention (Argument A-see brief pages 5-6).

In response to argument A, it should be understood that Cook, the primary reference relied upon by the examiner in rejecting the claims teaches a method and apparatus in which text messages are communicated between parties. Upon establishing a connection, one party can initiate voice chat/messages by activating an icon. Cook discloses many types of chat/messaging techniques. However, Cook does not specifically state that the text messages sent are instant messages. The PowWow reference was utilized to teach text messages can be instant messages. PowWow discloses a very similar system in which two or more parties are communicating via text instant messages. Upon activation of an icon, the parties can switch to voice instant messaging. The two references use strikingly similar systems. All the claimed

elements were known in the prior art and recited in the references. One skilled in the art could have combined the elements as claimed by very known and common methods with no change in their respective functions and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Furthermore, the claimed limitations would have been obvious because relying on and transitioning to quicker and faster instant messages from other forms of text messaging was part of the ordinary capabilities of a person of ordinary skill in the art, in view of the teaching of the technique for improvement in other situations. The transitioning from one form of communication was known to be common at the time of the instant application and was easily accomplished by one of ordinary skill in the art.

Therefore the examiner's conclusion of obviousness is based upon proper reasoning. The examiner's recognizes that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

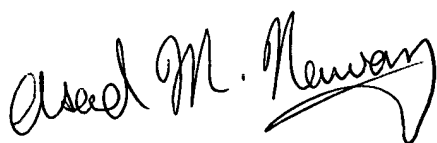
Therefore, the examiner maintains that the combination of Cook and PowWow is a valid combination and that the combination teaches the invention as claimed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

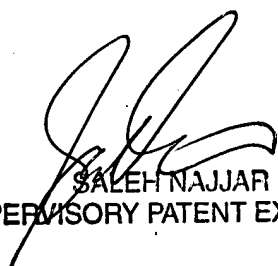
Respectfully submitted,



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